Remarks/Arguments

Claims 1-35 are pending in this application. Claim 26 has been amended herein at the suggestion of the Examiner. Applicants wish to thank the Examiner for a relatively detailed Advisory Action.

The Examiner has rejected claims 21-35 under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants respectfully disagree. Claims 21-25 are directed to a system and use permissible means-plus-function language to recite the structure of the system. 35 U.S.C. § 112, paragraph 6, provides: "an element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." Additionally, "35 U.S.C. 112, sixth paragraph states that a claim limitation expressed in means-plus-function language 'shall be construed to cover the corresponding structure...described in the specification.' " See MPEP 2181(II). Accordingly, a patentee may generically define a structure for performing a particular function through the use of a means expression, provided that structure for performing the recited function is disclosed in the patent specification. The specification of the current application describes various structures for performing the functions recited in claims 21-25. For example, Figures 2, 4 and 5 and corresponding descriptions of these figures in the specification provide such support. In the Final Office Action, the Examiner stated that "the structure must include a specific algorithm." In the Advisory Action, the Examiner stated (emphasis added):

> "Applicant may express the algorithm in any understandable terms
> including as a mathematical formula, in prose, in a flow chart or in
> any other manner that provides sufficient structure. "

Applicants submit that such algorithm is present in the application as shown in the flow chart of Figure 1 and in paragraphs [0018]-[0020] of the specification. Applicants submit that such algorithm is sufficient to obviate the Section 112 rejection and thus, respectfully request reconsideration and withdrawal of the section 112 rejection of claims 21-25.

With regard to the Section 112 rejection of claim 26, Applicants have amended claim 26 to recite a system and to change "engine" to "computer," as suggested by the Examiner.

Applicants thank the Examiner for such suggestion and request reconsideration and withdrawal of the Section 112 rejection of claim 26 and claims 27-35 which are dependent therefrom.

The Examiner has rejected claims 21-35 under 35 U.S.C. 101 as directed to non-statutory subject matter. Claim 21 recites an "apparatus" and because an apparatus is not software, claim 21 is not directed to software per se, as indicated by the Examiner. Additionally, as discussed above, a patentee may generically define a structure for performing a particular function through the use of a means expression, provided that structure for performing the recited function is disclosed in the patent specification. The specification of the present application teaches that the software and hardware work in concert together to perform at least one of the means-plus elements of claim 21. For example, on paragraph [0009] of the present application,

> ". . . the invention is, at least in part implemented via a computing platform or a collection of computing platforms interconnected by one or more networks . . . . A computer program product or products containing computer programs with various instructions can be used to cause the hardware to carry out, at least in part, the methods of the invention. Software engines can be operated on servers or workstations. Data repositories are operatively connected to the engines. Such data repositories can reside on the same platform as some or all of the various software engines or they can reside on a database server connected over a network."

Thus, the means-plus functionality in claim 21 refers to software <u>in combination with hardware</u>. The Examiner contends that a broad reasonable interpretation of claim 21 could result in only software. However, it is impossible under the laws of physics for software by itself to perform any of the functions of claim 21, let alone all of the functions of claim 21. For the Examiner to interpret claim 21 as being performed by only software renders claim 21 inoperable. Such interpretation is unreasonable. Any <u>reasonable</u> interpretation of claim 21 would require claim 21 to require at least one hardware component. For example, claim 21 recites "means for receiving account-holder requests." Software cannot receive any requests without assistance from at least one hardware component (e.g. a computer processor) recited in the specification.

In the Advisory Action, the Examiner stated "since Applicant's specification indicates an embodiment whereby the 'means for receiving,' 'means for matching,' 'means for matching,' etc. lack storages on a medium, no underlying functionally occurs. . . ." Applicants submit that the means stated in claim 21 are stored in a tangible medium as disclosed in paragraph [0009] of

the specification. Further, to suggest that the elements of claim 21 have no functionality is nonsensical. Indeed, each of the elements recites functionality, such as "receiving account-holder requests," "matching the specific requests from among the account-holder requests to the specific third-party participants, "forwarding the specific requests to the specific third-party participants," "receiving participant confirmations," and "forwarding an account-holder confirmation." On the contrary to the Examiner's position, claim 21 does have a practical application. For all of the above reasons, Applicants submit that claim 21 is directed to statutory subject matter. Claims 22-25 are dependent from independent claim 21 and as such, are also directed to statutory subject matter.

With regard to the Section 101 rejection of claim 26, claim 26 has been amended to recite a system that includes a computer, per the suggestion of the Examiner. As such, claim 26 and all claims dependent therefrom recite patentable subject matter.

For all of the above reasons, claims 21-35 are directed to patentable subject matter and withdrawal of the Section 101 rejection of claims 21-35 is respectfully requested.

The Examiner has rejected claims 1-35 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 7,376,587 to Neofytides et al. ("Neofytides"). A claim is anticipated only if each and every element as set forth in the claim is found in the reference. M.P.E.P. 2131. All of Applicants' claims, as amended herein, recite elements not fairly taught or disclosed in Neofytides.

For example, independent claims 1, 11, 21 and 26 recite that at least one specific request from among the account-holder requests authorizes a specific third party participant to perform a plurality of recurring third-party transactions on behalf of the account holder. Applicants can find no such teaching in the cited portions of Neofytides, but rather a discussion of a one-time transfer of money from one person to another person. In the Advisory Action, the Examiner cited column 1, line 57- column 2, line 2 of Neofytides for teaching the above limitation of the independent claims. Column 2, lines 1-2 of Neofytides recites ". . . an individual may use the payment enabler to schedule future or recurring transactions." Accordingly, Neofytides only discloses that an account holder may schedule recurring transactions to be performed by his bank to a third party. However, Neofytides does not teach or suggest that the account-holder

authorizes a *specific third party participant* to perform a plurality of <u>recurring</u> third-party transactions on behalf of the account holder.

Also, each of Applicants' independent claims recites "receiving, at the financial institution . . . ." The Examiner stated that Neofytides inherently discloses a financial institution because Neofytides mentions a bank account. Nonetheless, Neofytides only relates to a single transaction performed *by the account holder* and does not inherently disclose that a financial institution receives requests to authorize *multiple recurring third-party transactions performed by a third party* on behalf of the account holder. The banks that are associated with the bank accounts in Neofytides only receive a request from the account holder to transfer money to another party via a single transaction. There is no disclosure in Neofytides of multiple third party transactions by a third party behalf of the account holder or a request to authorize such third party transactions. Such limitation is not taught or suggested in Neofytides. For a proper rejection under Section 102, the Examiner must demonstrate that the identical invention is "shown in as complete detail as contained in the....claim," and that the elements are "arranged as required by the claim...." M.P.E.P. § 2131. Such burden has simply not been met.

With respect to claim 1, Neofytides does not disclose receiving "a confirmation that the at least one specific third-party participant's accounting system has been updated based on the at least one specific request," as recited in claim 1. This is because Neofytides only deals with a one-time transfer of money from one person to another and not a plurality of recurring *third-party* transactions. In the Final Office Action, the Examiner cited column 13, lines 4-13 and column 14, lines 20-27 as allegedly teaching this limitation of claim 1. However, Neofytides does not disclose a third party updating an accounting system. In fact, there is no mention whatsoever in Neofytides of any accounting system. Further, there is certainly no disclosure in Neofytides of a *confirmation* that the accounting system has been updated. In the Advisory Action, the Examiner cited column 9, line 52 – column 10, line 49 of Neofytides. However, this portion of Neofytides only relates to a user updating an address book. There is no disclosure of "at least one specific third-party participant's accounting system" being updated. Clearly, an address book cannot be reasonable interpreted as an accounting system. Additionally, updating the address book is done by the account holder and not by a third party. There is no confirmation discussed in Neofytides at all and there is certainly no disclosure in Neofytides of a confirmation

Neofytides of a confirmation based on at least one request by a third party to perform recurring transactions. Accordingly, claim 1 is submitted to be patentably distinct over Neofytides.
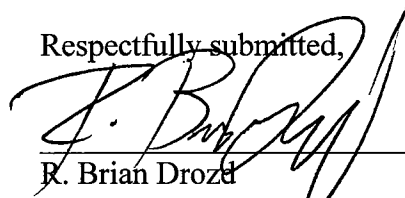
For at least the above-identified reasons, all of the independent claims, including claims 1, 11, 21, and 26, are patentable over Neofytides and reconsideration and withdrawal of the section 102(e) rejection of such claims is requested.

Applicants submit that since, based on the above arguments, all of the independent claims rejected under section 102 are patentable, all of the dependent claims are also patentable for at least the same reasons. However, Applicants would like to specifically comment on claim 6, where the Examiner points to col. 4, lines 1-10 of Neofytides as teaching "how a user directs a money transfer request to another individual or entity." Claim 6, as amended recites "the account-holder requests comprise at least one direct-deposit request to authorize the at least one specific third-party participant to periodically direct deposit funds to the account." Applicants can find no such teaching in the cited portions of Neofytides, but rather a discussion of a one-time transfer of money from one person to another person. In the Final Office Action, the Examiner cited column 1, line 57 to column 2, line 2 of Neofytides, which states that an account holder may schedule future or recurring transactions. However, there is no mention of authorizing a *third-party participant* (and not the account holder) to periodically direct deposit funds to the account. Neofytides clearly does not teach "at least one direct-deposit request to authorize the at least one specific *third-party participant* to periodically direct deposit funds to the account," as recited in claim 6. As such, Applicant's request reconsideration and withdrawal of the section 102 rejection of claim 6 as well as the rejections of all other dependent claims.

Applicants believe they have responded to the Examiner's concerns, and that the application is in condition for allowance. Reconsideration of this application as amended is hereby requested.

Respectfully submitted,

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